

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ROCCO E. GIORDANO,

Plaintiff,

v.

FERDINAND OFFRAY IV,

Defendant.

18 CV 6816

Civil Action No.

JURY TRIAL DEMANDED

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND RELATED CLAIMS**

Plaintiff, Rocco E. Giordano, alleges his complaint against Defendant, Ferdinand Offray IV as follows:

NATURE OF THE ACTION

1. This action arises from Defendant's infringement of Plaintiff's "ownership" and exclusive "use" rights in the FADED ROYALTY™ mark in conjunction with clothing and other related goods. Despite Plaintiff being the "senior user" of the trademark FADED ROYALTY™ for clothing related goods, the Defendant has fraudulently registered the FADED ROYALTY™ mark with the United States Patent and Trademark Office and is willfully infringing Plaintiff's exclusive rights in the aforementioned mark by selling and offering for sale, clothing items under Plaintiff's trademark.

2. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Defendant and Plaintiff resulting in the unjust enrichment of Defendant by using Plaintiff's trademark.

3. Defendant has also attempted to extort payment from Plaintiff by offering to transfer ownership of the U.S. trademark registration in exchange for a payment from Plaintiff. Defendant has engaged in acts of interfering with Plaintiff's business partners by asserting ownership of the FADED ROYALTY™ brand and by contacting business associates and affiliates of Plaintiff claiming that they are infringing Defendant's fraudulently obtained trademark registration.

JURISDICTION AND VENUE

4. This Court has jurisdiction over this action pursuant to Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c). Plaintiff also brings his complaint under federal diversity jurisdiction, 28 U.S.C. 1332, as the parties are completely diverse in citizenship and the amount in controversy exceeds \$75,000.00.

5. This Court has personal jurisdiction over the Defendant because Defendant engages in business activities in, and directed to the State of New York within this judicial district and because Defendant has committed tortious acts aimed at and causing harm within the State of New York and this judicial district.

6. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff owns and operates his FADED ROYALTY™ retail clothing business. The Defendant also transacts business in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district.

THE PARTIES

7. Plaintiff, Rocco E. Giordano is an individual with an address at 40 Clinton Street, New York, NY 10002.

8. Upon information and belief, Defendant Ferdinand Offray IV, is an individual residing at 598 E. Rio Grande Street, Pasadena, CA 91104.

FACTS

9. Since at least as early as 2000, Plaintiff Rocco E. Giordano has been selling headwear, t-shirts and other clothing items under the FADED ROYALTY™ and FADED™ brand names.

10. After many years of independently operating his FADED ROYALTY™ clothing business, Plaintiff purchased and registered the domain name www.fadedroyalty.com with godaddy.com on October 14, 2005 to offer his clothing products via the worldwide internet.

11. Plaintiff secured his first commercial lease and opened up his first official flagship clothing boutique for his FADED ROYALTY™ brand in October of 2008.

12. Since the opening of Plaintiff's flagship FADED ROYALTY™ clothing boutique in 2008, Plaintiff has operated and overseen the business of the FADED ROYALTY™ brand at four (4) flagship clothing locations exclusively for the FADED ROYALTY™ brand.

13. In addition to Plaintiff's retail clothing locations that he has sold the FADED ROYALTY™ brand from, Plaintiff sells, and promotes the sale of his clothing via his website www.fadedroyalty.com.

14. Plaintiff also wholesales his FADED ROYALTY™ clothing products to clothing retail stores in California, Las Vegas, Chicago, Florida, Pennsylvania, New Jersey, New York and in various other States.

15. Plaintiff's clothing products are available on popular clothing websites including but not limited to www.karmaloop.com and Plaintiff's clothing products are available at nationwide LIDS® cap stores.

16. The FADED ROYALTY™ brand is famous and enjoys a superlative reputation for quality clothing products in the marketplace.

17. The FADED ROYALTY™ brand and Plaintiff's clothing products under the FADED ROYALTY™ mark have appeared on national television networks and Plaintiff's FADED ROYALTY™ clothing products have been worn and endorsed by celebrities, musicians and numerous public figures.

18. When consumers encounter the FADED ROYALTY™ brand in connection with clothing related goods, they associate Plaintiff and his Faded Royalty business as the source provider of clothing products under the FADED ROYALTY™ mark.

19. By and through Plaintiff's longstanding and continuous use of the FADED ROYALTY™ mark in interstate commerce, Plaintiff has developed goodwill in the FADED ROYALTY™ brand name and all of Plaintiff's FADED ROYALTY™ clothing products are made in the United States.

20. Plaintiff is the owner of United States Trademark Serial Application No. 87/268,193 for the mark FADED ROYALTY™ that claims "first use" of the mark back to August of 2000. (**See Exhibit A**).

21. It is well established under the Lanham Act and/or other State and common law statutes that ownership rights in a mark are established by use in commerce. It is also well-established law that the first person to use a mark in connection with the sale and/or offering of a particular product or service is the rightful owner of the mark in connection with the goods/services in which the mark was first used.

22. Plaintiff has established senior use and priority rights in the FADED ROYALTY™ mark that predate any first use claim in which Defendant can rely upon.

23. Upon information and belief, Defendant initially started using the FADED ROYALTY™ mark as a DBA for his music related goods and services that he promoted under the name Faded Royalty Enterprises.

24. On or about December of 2010, Defendant joined the Twitter social media platform and was promoting music and entertainment in connection with the names FADED ROYALTY ENTERPRISES, INC. and FADED ROYALTY PRODUCTIONS. (See Exhibit B).

25. In November of 2010, Plaintiff started www.fadedroyalty.tumblr.com as an official blog that continuously updated consumers of new items and ideas pertaining to Plaintiff's clothing products.

26. Upon information and belief, sometime during the year 2010, Defendant became aware of the popularity of Plaintiff's FADED ROYALTY™ brand and was aware that Plaintiff was operating a clothing business under the FADED ROYALTY™ mark.

27. On December 28, 2010, Defendant contacted Plaintiff via email and alleged use of the FADED ROYALTY™ mark.

28. On December 29, 2010, Plaintiff was contacted by Marc LaFountain of Tumblr's legal department in order to determine whether www.fadedroyalty.tumblr.com was owned by Plaintiff or Defendant. After reviewing the evidence of record, Mr. LaFountain determined that www.fadedroyalty.tumblr.com and all items images and items posted relating to "FADED ROYALTY™" were owned by Plaintiff.

28. Despite only having used the FADED ROYALTY™ name in connection with musical related goods and services, on December 31, 2010, Defendant filed a fraudulent application with the United States Patent and Trademark Office to secure the FADED ROYALTY™ mark in the apparel category.

29. Defendant's has claimed use of the FADED ROYALTY™ mark in connection with "Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms," and fraudulently claims first use of November 25, 2008.

30. Upon information and belief, to date, Defendant has never produced or manufactured "pants, jackets, footwear or athletic uniforms under the FADED ROYALTY™ brand" rendering his first use claims false and fraudulent.

31. On September 30, 2014, Defendant posted content and an image on his Instagram® account stating "**Official #FadedRoyaltyApparel Photo Shoot. Tees, Hats, Beanies, Sweaters & Online Store Coming Soon...**" (See Exhibit C).

32. On September 30, 2014, Defendant posted content on his Twitter® social media account stating "**Working on Product. Official @FDRAAPPAREL coming soon... #FadedRoyalty #FDR #FDRAC**". (See Exhibit D).

33. Defendant's questionable use of the FADED ROYALTY™ mark in connection with clothing commenced after Plaintiff's first use of the FADED ROYALTY™ mark.

34. Defendant obtained his FADED ROYALTY mark fraudulently by submitting false and inaccurate claims to the United States Patent and Trademark Office.

35. Defendants continued use of the FADED ROYALTY™ mark in connection with clothing related goods is likely to cause confusion as to the source of clothing related goods under such brand name.

36. Defendant has used his fraudulently obtained trademark of the FADED ROYALTY brand to tortuously interfere with ongoing and continuous business contractual dealings with other third party companies in the apparel industry.

37. In a September 8, 2014 email correspondence, Defendant acknowledged Plaintiff's long standing rights in the FADED ROYALTY™ mark and stated "**We are aware that Faded Royalty® has been being used for a number of years.**" "**Therefore, if you are interest[ed] in obtaining the trademark of Faded Royalty® we are open to negotiation.**"

38. In essence, Defendant has used his fraudulently obtained trademark registration to attempt to extort payment from Plaintiff and has used his illegally obtained trademark to interfere with Plaintiff's business dealings and operations under the FADED ROYALTY brand name.

FIRST CAUSE OF ACTION

UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a))

39. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 38 of this Complaint.

40. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the FADED ROYALTY™ mark or any confusingly similar variation in connections with clothing and related goods.

41. Defendant by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendant and Plaintiff's clothing goods and accessories come from one and the same source, and Defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

42. Defendants have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

43. By reason of Defendants willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

SECOND CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

44. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 43 of this Complaint.

45. Defendant's conduct constitutes deception by which Defendant's goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

46. Defendants unauthorized use of Plaintiff's FADED ROYALTY™ mark is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

47. By reason of the foregoing, Defendants have infringed and continue to infringe on Plaintiff's common law rights in the FADED ROYALTY™ mark and Defendant have become unjustly enriched by such acts of infringement.

48. Defendants unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights, as Defendant has reason to know of Plaintiff's rights in the FADED ROYALTY™ mark.

THIRD CAUSE OF ACTION

UNJUST ENRICHMENT

49. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 48 of this Complaint.

50. Defendants have unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's FADED ROYALTY™ mark.

51. Defendants actions constitute unjust enrichment.

FOURTH CAUSE OF ACTION
UNJUST ENRICHMENT

52. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 51 of this Complaint.

53. Plaintiff has business relationships in the furtherance of operating his FADED ROYALTY™ clothing business. Defendant has contacted several parties he knows Plaintiff to be in business dealings with regarding the FADED ROYALTY™ brand and Defendant has advised these parties about his fraudulently obtained trademark in an attempt to prevent future and continuing business between Plaintiff and said business partners and/or affiliates.

54. As a result of the foregoing, Plaintiff has been injured, and is entitled to special and exemplary damages, in an amount to be determined at trial.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that Defendant, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term FADED ROYALTY™, or any colorable imitation thereof; (b) advertising, operating a website, using business stationary or offering any goods or services using the trade name, trademark, domain name, URL, or any other indicia of origin including in whole or part the terms FADED ROYALTY™, or any colorable imitation thereof; (c) otherwise engaging in any acts of unfair competition and infringement which tend to injure Plaintiff's rights in the FADED ROYALTY™ mark.

2. That Defendant be required to account to Plaintiff for any and all profits derived by it, and to compensate Plaintiff for all the damages sustained by reason of the acts complained of herein, and that the damages herein be trebled pursuant to the Trademark Act.
3. That Defendant be ordered to deliver up for destruction any and all infringing materials bearing the FADED ROYALTY™ mark, and any colorable imitation thereof, in whole or part.
4. That Defendants trademark registration, United States Trademark Registration No. 4,394,536 be cancelled.
5. That Plaintiff be awarded punitive and treble damages for Defendant's egregious and willful acts in disregard for Plaintiff's exclusive use rights in his registered trademarks in connection with clothing.
6. The Defendant be liable for damages in the amount of \$500,000.00.
6. That Defendant be required to place advertisements or send notifications to past and present customers that it improperly has been using the FADED ROYALTY™ mark.
7. That Plaintiff be awarded the cost and disbursements of this action.
8. That Plaintiff have such other and further relief as the Court deems just and proper.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: July 30, 2018
New York, New York

Respectfully submitted,
Rocco E. Giordano - Pro Se

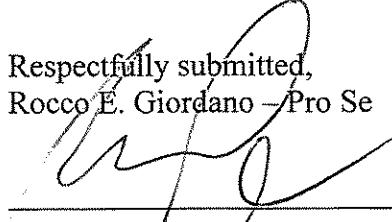

Rocco E. Giordano
Pro Se Plaintiff
40 Clinton Street
New York, New York 10002
(917) 848-4127
[REDACTED] STORE FRONT.
Ri6HT

EXHIBIT A



United States Patent and Trademark Office

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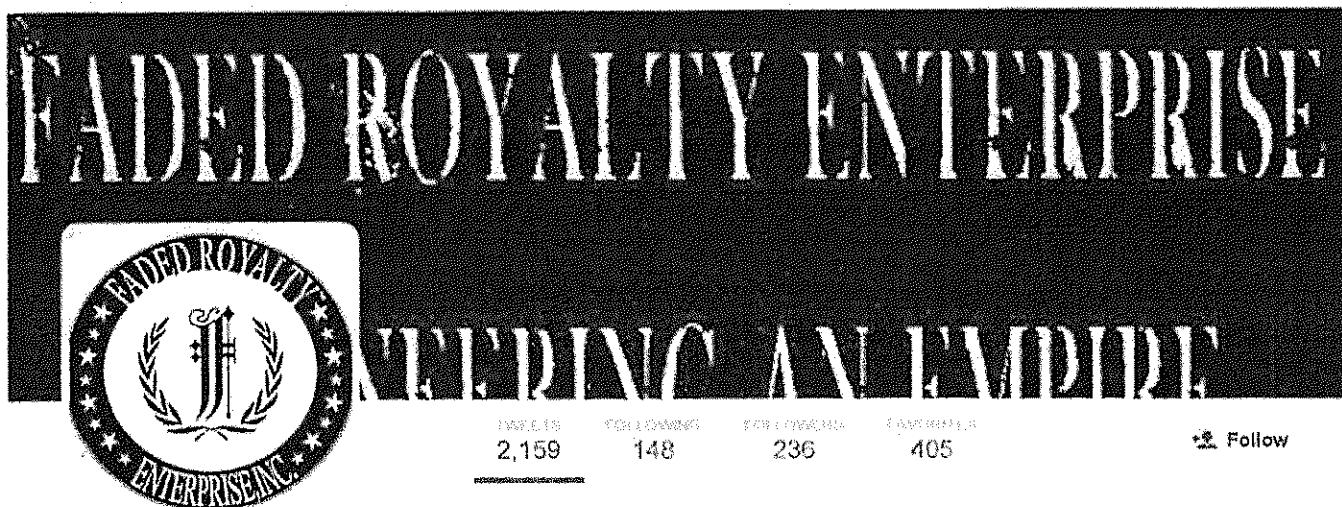
FADED ROYALTY

Word Mark	FADED ROYALTY
Goods and Services	IC 025. US 022 039. G & S: Headwear; Hoodies; Jackets; Sweaters; T-shirts; Caps; Crew neck sweaters; Short-sleeved or long-sleeved t-shirts; Skullies. FIRST USE: 20000801. FIRST USE IN COMMERCE: 20000801
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	87268193
Filing Date	December 14, 2016
Current Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) Giordano, Rocco E INDIVIDUAL UNITED STATES 461 Central Avenue Jersey City NEW JERSEY 07307
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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EXHIBIT B

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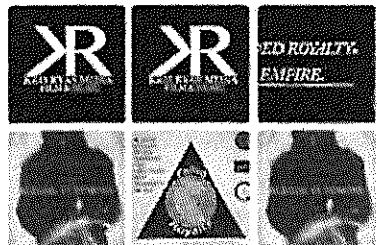
FADED ROYALTY® ENTERPRISE, INC.
| Music, Fashion & Entertainment.
#FadedRoyalty #EndeRoyaltyEnterp

WORLD WIDE

FDROYALTY.COM

Joined December 2010

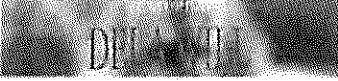
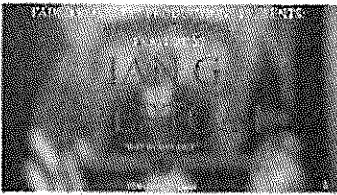
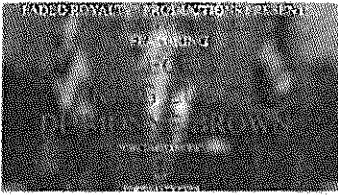
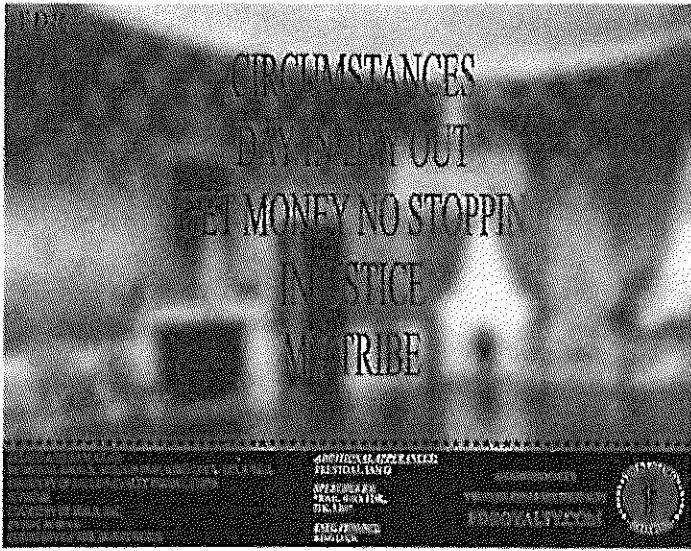
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Faded Royalty® Enterprise, Inc.

Production Apparel Co.

OCTOBER 17, 2014



The Highly Anticipated Sequel From Faded Royalty® Productions "The Collection" Vol.2 Ep is just in time to end the year. Produced entirely by King Luck (Faded Royalty® Prod.) This EP features some of Hip-Hop's Brightest Independent Artist of today's music.

Exec.Prod. King Luck

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OCTOBER 7, 2014



Money Man Commercial

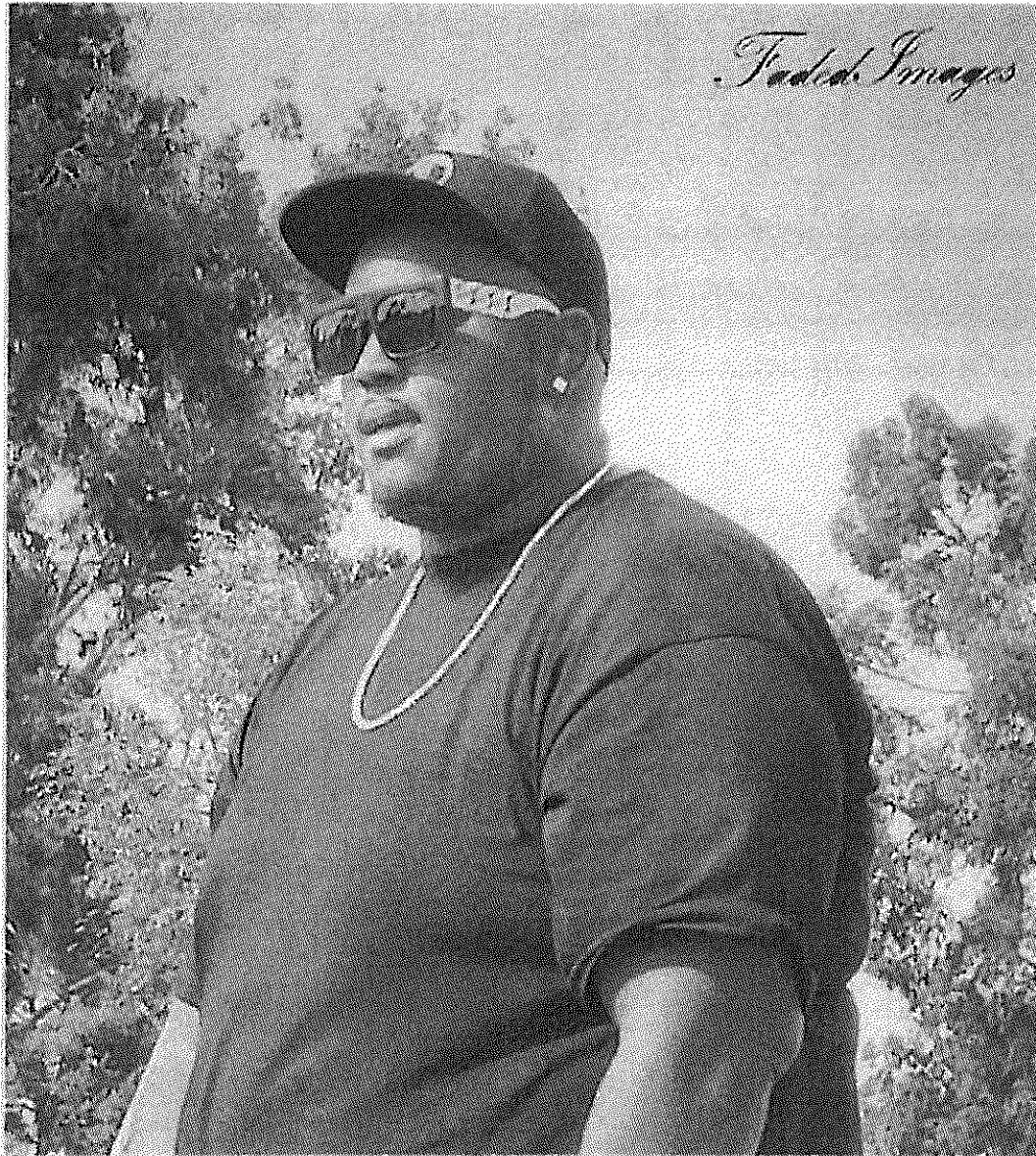
Performed By: ZytoCrowns

Music By: KING LUCK

Shot By: KRM

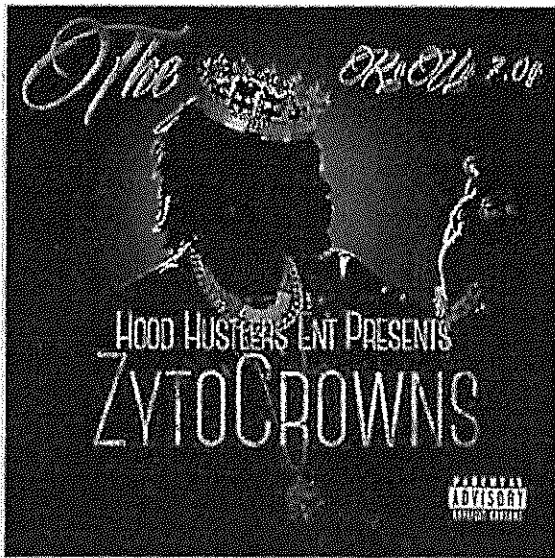
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SEPTEMBER 29, 2014



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SEPTEMBER 22, 2014

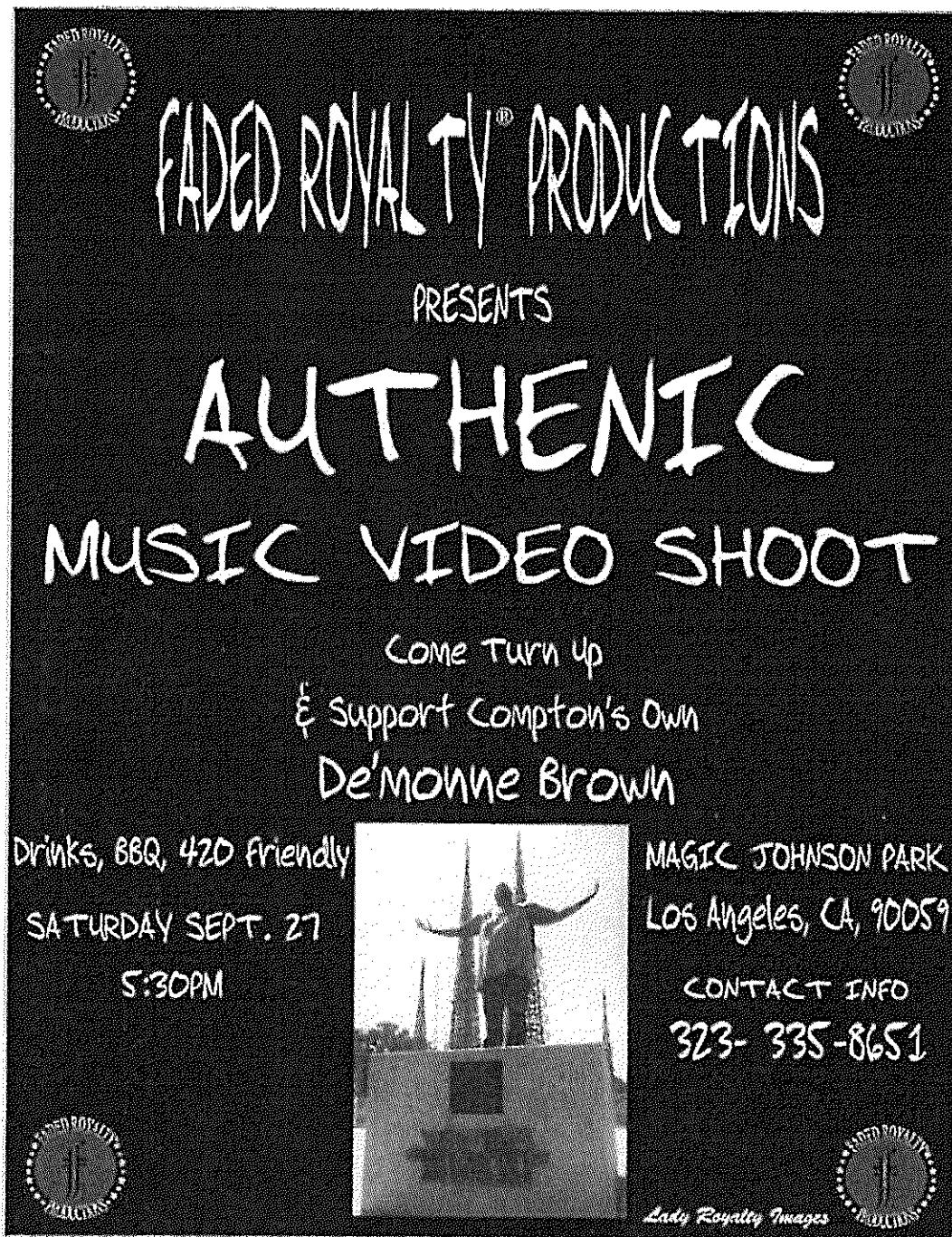


THE HIGHLY ANTICIPATED SOPHOMORE PROJECT FROM
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SEPTEMBER 16, 2014



MUSIC VIDEO COMING SOON...

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SEPTEMBER 9, 2014

EXHIBIT C

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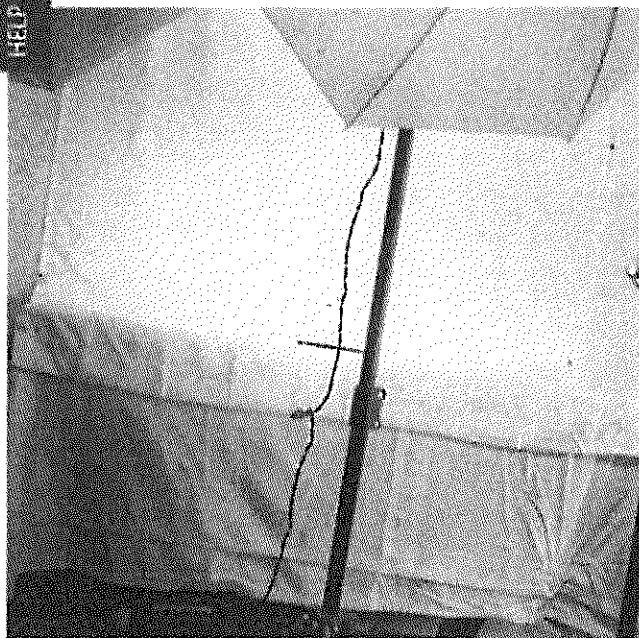
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ADVERTISING

EXHIBIT D



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